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**OFFICE OF PETITIONS**

In re Application of  
Bates et al.  
Application No. 09/881,168  
Filed: June 14, 2001  
Attorney Docket No. ROC920010105US1

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: **DECISION DISMISSING PART**  
: **REQUEST AND HOLDING OTHER**  
: **PART REQUEST IN ABEYANCE**  
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This decision is in response to applicants' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR § 1.705)" timely<sup>1</sup> filed requesting that the Office adjust the determination to reflect a value of 237 days.

Applicants' request for reconsideration is **DISMISSED** as to applicants' assertion that a successful appellate review occurred in this application and applicants' request for reconsideration as to Office delay in not issuing the application within three years of the filing date is **HELD IN ABEYANCE** until the issuance of the patent.

Applicants assert that they are entitled to PTA for Office delay on two grounds: 1) the application contained a "successful appellate review" within the meaning of 1.702(e) and (2) the Office did not issue the application with three years of the filing date of the application.

Applicants arguments are not persuasive. As to applicants' assertion that a successful appellate review occurred, the Office notes that the Board of Patent Appeals and Interferences never made a decision in the application and accordingly a "successful appellate review" within the meaning of 37 CFR 1.702(e) has not occurred.<sup>2</sup>

As to applicants' assertion that the patent issued more than three years after the filing date,

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<sup>1</sup>Issue fee paid on 10-13-2004.

<sup>2</sup>In order to be a successful review, at least one claim must be reversed on all grounds under to be considered a successful appellate review.

knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term is accrued pursuant to 37 CFR 1.703(b).

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

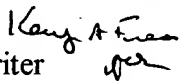
Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. Any delays in issuance of the patent longer than four months of the payment of the issuance fee and other requirements being satisfied will be reflected in the issue notification letter that is mailed to applicants approximately three weeks prior to the issuance of the patent.

The Office acknowledges the payment of the \$200.00 application fee. No additional fees are required by this Office.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757.

  
Karin Ferriter  
Senior Legal Advisor  
Office of Patent Legal Administration

Office of Deputy Commissioner  
for Patent Examination Policy